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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/547,965

09/08/2005

Hanjo Yang

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EXAMINER

HOPKINS, CHRISTINE D

ART UNIT

PAPER NUMBER

3735

MAIL DATE

DELIVERY MODE

04/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/547,965	Applicant(s) YANG, HANJO	
	Examiner CHRISTINE D. HOPKINS	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 April 2009 has been entered. Claims 1 and 6 are pending. The Examiner acknowledges the amendments to claims 1 and 6.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 at line 38 recites that "two different pressures are applied to a portion of skin of a patient under the moxibustion part and another portion skin under the cupping part at the same time". While the specification

supports that operation of the compressor decreases air pressure in the cupping part, it does not support two different pressures being applied to the skin of a patient under the moxibustion part and the cupping part at the same time as recited by claim 1.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 at line 38 recites "two different pressures are applied to a portion of skin of a patient under the moxibustion part and another portion of skin under the cupping part at the same time." It is unclear as to whether or not two different pressures are applied by each part, or a total of two different pressures are applied to the skin, one pressure applied under the moxibustion part, and a second different pressure applied by the cupping part.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 and 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 recites that "two different pressures are applied to a portion of skin under a patient under the moxibustion part and another portion of skin under the cupping part" and "the cupping part keeps a cupped space

enclosed by the cupping part and the skin in a controllable low pressure.” This recites a positive relationship to the human body. However, the human body is non-statutory subject matter and cannot be positively recited.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

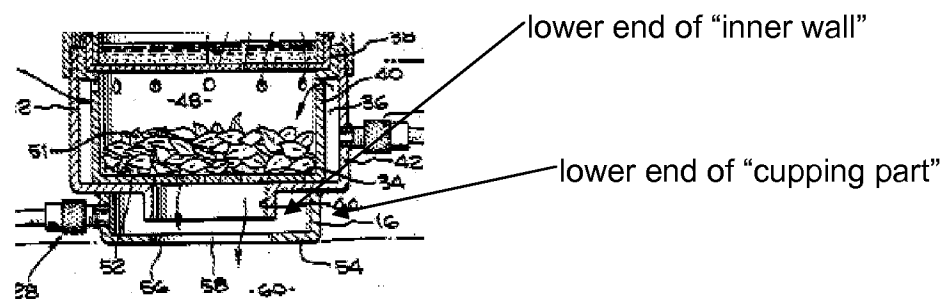
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No: 3946733 to Han (hereinafter “Han”). Han teaches a cupping and moxibustion device, which includes a moxa pot (32) located on the upper portion (12) for containing moxa (51) therein, a moxibustion part formed just above the treatment opening (56) of the lower treatment portion (58) to communicate with the moxa pot (32), and a cupping part (16) divided from the upper portion and the moxibustion part and located around the moxibustion part (fig. 2), comprising: a body (10) having a seat (34) formed therein for seating the moxa pot (32) inside the body and a smoke discharge hole (28) formed on a side thereof, the smoke discharge hole being located below the seat and above the moxibustion part to communicate with the moxa pot (col. 3, lines 1-26); an air pump (18) connected with the air suction hole (22) to supply air into the body, whereby moxa (51) contained in the moxa pot (32) is burned when the air pump is operated and the air is forcibly induced into the body, at which time, heat and smoke of

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the moxa are moved downwardly toward the moxibustion part, and then, discharged to the outside through the smoke discharge hole (col. 3, line 65 to col. 4, line 10).

The air pump (18) is connected to the air suction hole and an air suction pipe, and a valve (24) is mounted on the air suction pipe (20), whereby an amount of the air supplied into the body can be controlled. The seat (34) is located on the upper portion (12) of the body (10) to catch the moxa pot (32) therein, and the moxibustion and cupping part respectively are located on the lower portion and are formed integrally in such a way as to form the body and are divided by the inner wall (44). The inner wall comprises a lower end and the cupping part (16) comprises a lower end, wherein the lower end of the inner wall and the lower end of the cupping part are in the same plane (see depiction). Regarding the indefinite nature of the claim with respect to the "two different pressures" applied to the skin as noted above, it is noted that this is also believed to be taught by Han since the moxibustion part and the cupping part would effect two different pressures on the skin of the patient, and the cupping part encloses a "cupped space" as demonstrated in the figure below.



The body also includes an air discharge hole (28) formed on the outer wall thereof to communicate with the cupping part (16), and an opening and closing unit (30) is inserted into the air discharge hole, for maintaining pressure inside the cupped space by controlling an air flow between the inside and the outside of the cupping part independently from the moxibustion part (col. 3, lines 61-65).

Han however does not teach that air suction hole (22) is connected to the lid (14) of the body (10). Applicant has not disclosed that having the air suction hole located on the lid instead of on the body of the moxibustion device solves any stated problem or is for any particular purpose. Moreover, it appears that the air hole placement of Han, or applicant's invention, would perform equally well with the hole for the air pump at any location above the base of the moxa pot. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Han such that the port for the air pump is located on the lid because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Han.

Response to Arguments

10. Applicant's arguments filed 3 April 2009 with respect to the rejection of claims 1 and 6 under 35 U.S.C. 103(a) citing Han ('733) have been fully considered and are not persuasive. Applicant contends that the treatment opening (56) as taught by Han is not divided so as to define two separate and isolated spaces along with skin of a patient. However, this argument is not persuasive. The claim language is silent with respect to

the moxibustion and cupping parts divided "so as to define two separate and isolated spaces along with skin of a patient" as argued. The claim recites only a "cupping part divided from the upper portion and the moxibustion part," which the reference to Han teaches as noted in the rejection above.

Applicant further contends that the rim (44) of Han does not reach all the way down to the lower end of the treatment opening (56), therefore "there is no such a thing as a cupping part of the invention." However, this argument is not persuasive. Element (16) is interpreted to be the "cupping part" since it is a concave vessel as shown in Fig. 2. Applicant also contends that there is no opening and closing unit and associated discharge hole for controlling a pressure of the cupped space under the cupping part. However, this argument is not persuasive. The opening and closing unit (30) maintains pressure inside the cupped space (col. 3, lines 61-65 and Figs. 1 and 2).

Applicant further contends that Han's outlet fitting (28) is "not like an air discharge hole of the invention." However, this argument is not persuasive. Since air passes through element (28) of Han (col. 3, lines 61-65), it is therefore interpreted to be an "air discharge hole" in accordance with claim 6.

Applicant also contends that the air suction hole is at a top portion of the lid, and the discharge hole is disposed at an outer wall of the body of the invention. However, this argument is not persuasive. Applicant's attention is directed towards the rejection where it is noted that Han does not teach that the air suction hole is connected to the lid of the body, however it appears that the air hole placement of Han, or applicant's invention, would perform equally well with the hole for the air pump at any location

above the base of the moxa pot. In view of the foregoing, the rejection of claims 1 and 6 under 35 U.S.C. 103(a) citing Han ('733) has been maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINE D. HOPKINS whose telephone number is (571)272-9058. The examiner can normally be reached on Monday-Friday, 7 a.m.-3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. D. H./
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